

## REMARKS

In response to the outstanding Office Action, Paper No./Mail Date 20040907, dated September 9, 2004, applicant has carefully studied the references cited by the Examiner and the Examiner's comments relative thereto.

Claims 1-3 have been amended to more clearly define applicant's invention and distinguish the same from the prior art.

Claims 1-9 remain in the application for consideration by the Examiner.

The specification has been amended to correct a typographical error.

No new matter has been added.

Reconsideration of the application, as amended, is respectfully requested.

The courtesy of the Examiner in granting a telephone interview on November 8, 2004 is graciously acknowledged.

In the September 9 Office Action, the Examiner rejected Claims 1-3, 6, 8, and 9 under 35 USC §102(b) as being anticipated by Rye (4,952,754). The Examiner stated:

"Regarding Claims 1-3, see Fig. 1, where 30 is the flange. It is a different material than the box as it is shown in section differently. Moreover, it has to be capable of being snapped over the box. Regarding Claims 6,8, and 9, see Figs. 1-4."

Amended Claims 1 and 3 recite in part a box formed of a "first material", a flange formed of a "second material", the flange being "molded around" an outer surface of the box, and "the first material of said box being different from the second material of said flange". Support for the first material and the second material being different is inherent in the specification where the list of possible materials used to produce the box (see page 10, lines 24-27) is different than the list of possible materials used to produce the flange (see page 12, lines 21-24). Thus, combining of the materials from each list results in electrical box systems having a box and a flange produced both from the same material and from different materials. Amended Claims 1 and 3 include the limitation that the first material of the box and the second material of the flange are different. Therefore, the possibility of the flange and the box being produced from the same material is excluded. Additionally, the specification lists one specific embodiment of the invention where the flange is produced from polyurethane (see page 12, lines 24-27). The list presented in the specification for box materials does not include polyurethane. Thus, in this specific embodiment, the materials of construction for

the box and the flange are different. The specification also points out that the box and the flange have different material properties, wherein the box is rigid, and the flange is flexible. Support for the flange being “molded around” the outer surface of the box is found in the specification on page 10, lines 27-30. No new matter is added by the amendment to Claims 1 and 3.

The flange formed of the second material is molded around an outer surface of the box formed of the first material. In Rye, the ring 30 (described as a flange by the Examiner) is not molded around an outer surface of the electrical box. The ring fits in a channel formed in an outer surface of the box. The channel requires additional structure and thus, additional costs, over the box of applicants’ invention. Additionally, the Examiner stated that the ring and the box Rye are constructed of different materials, since they are shown in section differently. However, in Fig. 3, both materials are sectioned as the same material. The specification also indicates that both the box and the ring are made of molded plastic (column 4, lines 1-5). This further supports the assertion that the material used to produce the box and the material used to produce the ring in Rye are not different. Neither the drawings nor the specification of Rye disclose the use of different materials for the ring and the box. For these reasons, it is submitted that Claims 1 and 3 are not anticipated under 35 USC §102(b) by Rye. Therefore, Claims 1 and 3 are submitted to be patentable over Rye.

Since Claim 3 is patentable over Rye, Claims 6, 8, and 9, which depend directly therefrom, are patentable over Rye.

Amended Claim 2 recites in part a box formed of a “first material”, a flange formed of a “second material”, the flange being “adhesively secured to” an outer surface of the box, and “the first material of said box being different from the second material of said flange”. Support for the first material and the second material being different is discussed above for Claim 1. Support for the flange being “adhesively secured to” the outer surface of the box is found on page 17, lines 4-9 of the specification. No new matter is added by the amendment to Claim 2.

The flange formed of the second material is adhesively secured to an outer surface of the box formed of the first material. In Rye, the ring 30 (described as a flange by the Examiner) is not adhesively secured to an outer surface of the electrical box. As previously discussed for Claim 1, the ring fits in a channel formed in an outer surface of the box.

Additionally, the Examiner stated that the ring and the box Rye are constructed of different materials, since they are shown in section differently. In Fig. 3, both materials are sectioned as the same material. As indicated above for Claim 1, the material used to produce the box and the material used to produce the ring in Rye are not different. For these reasons and those discussed above, it is submitted that Claim 2 is not anticipated under 35 USC §102(b) by Rye. Therefore, Claim 2 is submitted to be patentable over Rye.

The Examiner rejected Claims 1-3 and 6-9 under 35 USC §102(b) as being anticipated by Nix et al. (4,724,281). The Examiner stated:

“Regarding Claims 1-3, the flange includes the caulk bead as seen in Fig. 6. The caulk is a different material than the box. Regarding Claims 6-9, see Figs. 1-8.”

Amended Claims 1 and 3 recite in part a box formed of a “first material”, a flange formed of a “second material”, the flange being “molded around” an outer surface of the box, and “the first material of said box being different from the second material of said flange”. Claims 1 and 3 also recite in part that the flange extends outwardly from the outer surface of the side wall of the box. The flange formed of the second material is molded around an outer surface of the box formed of the first material, and extends outwardly therefrom. In Nix et al., the flange and the box are molded as a unitary structure from a single material. The flange is not molded around an outer surface of the box, nor is the flange produced from a material different from the box. The Examiner states that the flange includes the caulk bead. Nix et al. does not state that the caulk is part of the flange, but to the contrary, states that the flange serves as a caulk receiving and holding surface (column 2, lines 65-68). The caulk is added well after the box is constructed, and during installation of the box. Caulk can be added to applicant’s structure during installation as well. It is submitted that the caulk does not form a part of the flange, and is an element entirely separate therefrom. Due to these structural differences, it is submitted that Claims 1 and 3 are not anticipated under 35 USC §102(b) by Nix et al. Therefore, Claims 1 and 3 are deemed to be patentable over Nix et al.

Since Claim 3 is patentable over Nix et al., Claims 6-9 which depend directly therefrom are patentable over Nix et al.

Amended Claim 2 recites in part a box formed of a “first material”, a flange formed of a “second material”, the flange being “adhesively secured to” an outer surface of the box, and “the first material of said box being different from the second material of said flange”.

Claim 2 also recites in part that the flange extends outwardly from the outer surface of the side wall of the box. The flange formed of the second material is adhesively secured to an outer surface of the box formed of the first material, and extends outwardly therefrom. As discussed above for Claim 1, the flange and the box in Nix et al. are molded as a unitary structure from a single material. The flange is not molded around an outer surface of the box, nor is the flange produced from a material different from the box. Due to these structural differences, as well as those discussed above for Claims 1 and 3, it is submitted that Claim 2 is not anticipated under 35 USC §102(b) by Nix et al. Therefore, Claim 2 is deemed to be patentable over Nix et al.

The Examiner's favorable reconsideration of the rejection based upon 35 USC §102(b) is respectfully requested.

The Examiner rejected Claims 4 and 5 under 35 USC §103(a) as being unpatentable over Nix et al. The Examiner stated:

"Regarding Claims 4 and 5, Nix et al. does not teach the specific materials. Official notice is taken that it is well known to employ the claimed materials for junction boxes and caulking. It would have been obvious to employ the materials to take advantage of their inherent properties."

As discussed above, Nix et al. does not teach all the features of applicant's invention as set forth in amended Claim 3 and Claim 3 is patentable over Nix et al. Since Claim 3 is patentable over Nix et al., Claims 4-5, which depend directly therefrom, are not obvious over Nix et al. and are also patentable.

The Examiner's favorable reconsideration of the rejection based upon 35 USC §103(a) is respectfully requested.

The other references cited by the Examiner, but not applied, have been studied and are not considered to be any more pertinent than the references relied upon by the Examiner.

It is submitted that the claims now properly define applicant's invention and distinguish it from the prior art. Reconsideration of the application, as amended, is respectfully requested. Accordingly, a formal Notice of Allowance is solicited.

While the applicant's attorney has made a sincere effort to properly define applicant's invention and to distinguish the same from the prior art, should the Examiner deem that other language would be more appropriate, it is requested that a telephone interview be had with the applicant's attorney in a sincere effort to expedite the prosecution of the application.